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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,889	01/16/2002	Allan R. Schwartz	99P1040US01	7936

36802 7590 07/21/2004

PACESETTER, INC.  
15900 VALLEY VIEW COURT  
SYLMAR, CA 91392-9221

EXAMINER
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OROPEZA, FRANCES P

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/051,889

Applicant(s)

SCHWARTZ ET AL. CN

Examiner

Frances P. Oropeza

Art Unit

3762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 3, 13 and 15.Claim(s) rejected: 1, 2, 4-12, 14 and 16.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**NICHOLAS D. LUCCHESI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**

*Nicholas D. Lucchesi*

**FRANCES P. OROPEZA**  
**ART UNIT 3762**

*JPB*  
**7/19/04**

Continuation of 3.

The Applicant's Agent, Mr. Ron Tamura, called Examiner Oropeza on Monday 7/12/04 stating his argument against the Er et al. reference in his June 03, 2004 response was based on an incorrect interpretation of American Inventor Protection Act. The Examiner reviewed the June 03, 2004 response and the 20040708 Advisory Action. The response in the 20040708 Advisory Action is withdrawn.

In response to the June 03, 2004 reply, the following comments are offered.

Applicant's reply relative to the arguments against the 35 U.S.C. 102(e) as being anticipated by Er et al. (US 5971341) have been fully considered, but they are not convincing. The Applicant states the Er et al. reference does not qualify as prior art for a rejection under both 25 U.S.C. 102(e) and 35 U.S.C. 103(a) via 35 U.S.C. 102(e) because the present application has been filed on or after November 29, 2000 and the subject matter of the Er et al. reference and the pending claims were, at the time the invention was made, subject to an obligation of assignment to the same organization.

The Examiner is unfamiliar with this ruling and hence disagrees with the Applicant's statement.

The Examiner offers the following understanding of the regulations. The instant application was filed on or after November 29, 1999, hence the 35 U.S.C. 103(c) exclusion would apply if the rejection in the application was a 35 U.S.C. 103(a) rejection. The 35 U.S.C. 103(c) exclusion relates to a rejection under 35 U.S.C. 103(a) using a 35 U.S.C. 102(e) reference that is commonly owned with the instant invention. In this situation, the Applicant need only make a simple statement regarding the common ownership, and the 35 U.S.C. 103(a) rejection based on the commonly owned 35 U.S.C. 102(e) reference is overcome. In the case of the instant invention, while the instant invention and the Er et al. invention were commonly owned, the rejection of record was under 35 U.S.C. 102(e). To overcome a rejection under 35 U.S.C. 102(e) when there is common ownership of subject matter, the Applicant must: 1) persuade the Examiner the rejection is incorrect, 2) amend the claim to make the rejection inapplicable, 3) show under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or 4) provide by an appropriate showing under 37 CFR 1.131. Since it is deemed the Applicant has not properly challenged the rejection of record, the rejection of record stands.

The Applicant's arguments related to the 35 U.S.C. 102(e) rejection as being anticipated by Alt et al. (US 6073049), filed 6/3/04, have been fully considered, but they are not convincing.

The Applicant asserts since the Alt et al. pacemaker is adapted to be selectively upgraded after implantation to provide different diagnostic, functional, and pacing operation modes, and since charges/upgrade codes are required to make changes to a pacemaker with limited functionality, the Alt et al. reference does not disclose or suggest a controller responsive to the receipt of a reset signal to retrieve parameter data from the parameter storage unit corresponding to another of the programming states and to implement the parameter data to change the programming state. The Examiner disagrees. The diagnostic, functional, and pacing operational modes are read to be individual treatment options that can be initiated at the physician's discretion (col. 5 @ 7-17). In this rejection, the operational modes are read as the "programming states" (col. 4 @ 16-20). While the pacemaker at the point of implantation can have limited pacing capability (col. 7 @ 2-35), it can also, at the point of implantation be given full capability so reprogramming by the physician can be undertaken without the need to have charges/ upgrade codes (col. 9 @ 29-45).

While, as asserted by the Applicant, the operational modes selected may require further parameter adjustments, the Examiner reads the different operating modes, such as an anti-bradycardia mode, an anti-tachycardia mode, and a rate adaptive pacing mode, as each having defined parameters that constitute a unique programming state, each state with defined parameters not requiring adjustment to be functional (col. 4 @ 16-30; col. 9 @ 29-45), hence Alt et al. teach in a fully capable pacemaker the limitation of a controller responsive to the receipt of a reset signal to retrieve parameter data from the parameter storage unit corresponding to another of the programming states and to implement the parameter data to change the programming state.

In response to the Applicant's argument that the reference fails to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e. the resetting of the programming state constituting "all operating parameters" and including the parameters associated with the diagnostic, functional and pacing operation modes) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See in re Van Geuns, 988 F.2d 1181, 26 USP2d 1057 (Fed. Cir. 1993).

The rejection of record stands for the reasons of record and the discussion above.

JPO  
7/19/04